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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/761,351 | 01/22/2004 | Craig Ullman | 559442600207 | 3432 |
| 43997 | 7590 | 05/20/2005 | EXAMINER | |
| OPTV/MOFO C/O MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD, SUITE 300 MCLEAN, VA 22102 | | | VU, VIET DUY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2154 | |

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/761,351

Applicant(s)

ULLMAN ET AL.

Examiner

Viet Vu

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4, 8, 11, 24, 30, 57, 64, 67, 80, 86-87, 113-114, 116, 120, 123, 136, 142-143, 169-174, 181-183 and 187-189 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/25/05</u> . | 6) <input type="checkbox"/> Other: _____ |

**Continuation of Disposition of Claims: Claims pending in the application are
1,2,4,8,11,24,30,57,64,67,80,86,87,113,114,116,120,123,136,142,143,169-174,181-183 and 187-189.**

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Art Rejections:

1. The text of 35 U.S.C. § 103(a) cited in the previous office action is hereby incorporated by reference.

2. The rejection of claims 1-2, 4, 8, 11, 24, 30, 57, 64, 67, 80, 86-87, 113-114, 116, 120, 123, 136, 142-143, 169-174, 181-183 and 187-189 under 35 U.S.C. § 103(a) as being unpatentable over Schein, U.S. pat. No. 6,002,394, applied in the previous office action, mailed 1/3/05, is hereby incorporated by reference.

3. Claims 1-2, 4, 8, 11, 24, 30, 57, 64, 67, 80, 86-87, 113-114, 116, 120, 123, 136, 142-143, 169-174, 181-183 and 187-189 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolzien, U.S. pat. No. 5,761,606.

Per claims 1, 4, 8, 11 and 24, Wolzien discloses a system and method for providing broadcast programming and online contents to users comprising:

- a) an online information provider (30, fig. 1) or providing online content accessible via URL (see col 5, lines 35-41),
- b) a transmission medium for transmitting programming signals having embedded online addresses (URLs) including radio, satellite, cable, fiber optics, etc., (col 5, lines 1-29),

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c) a receiver/decoder for decoding the address from the signal and using the address to automatically retrieve and play online content to user in conjunction with the program (see col 5, line 42 - col 6, line 58).

Wolzien does not explicitly show a signal encoder for combining the address with the programming signal.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize any conventional signal encoder in Wolzien because it would have enabled embedding the address within the programming signal, e.g., using vertical blanking intervals (VBI) (see col 5, lines 48-67).

Per claim 2, Wolzien does not teach providing the transmitter at a web-hosting site.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the transmitter at a web-hosting site because it would have enabled the system to coordinate the broadcast program and online information sources more easily.

Per claim 30, it is noted that Wolzien's teaching is also applicable to digital programming signal (see col 6, lines 1-7).

Claims 57, 64, 67, 80, 86-87, 113-114, 116, 120, 123, 136, 142-143, 169 and 172-174 are similar in scope than that of

claims 1-2, 4, 8, 11, 24 and 30 and hence are rejected for the same rationale set forth above.

Per claims 170-171, 181-183 and 187-189, Wolzien teaches embedding the address at a predetermined timing relationship with the video programming (see col 5, lines 60-67).

Response to Amendment:

4. Applicant's arguments filed on 3/25/05 with respect to the rejection over Schein have been fully considered but are not found persuasive.

Applicant alleges that Schein (disclosure of '650 application) does not teach providing online address in conjunction with the program.

This is not found persuasive. Schein teaches providing a link in conjunction with a program to a database or online provider (see page 14, second paragraph of '650). It is submitted that such a link to the online database would have included at least a network address to enable the user to establish communication with the database (see page 15, first paragraph of '650).

Applicant also alleges that the Schein fails to teach using the address to automatically retrieve and play online content.

This is not found persuasive. Since the present claims do not require a specific means or step to perform the alleged function, it is irrelevant as to whether Schein discloses the alleged function. Furthermore, it is well known in the art that a network address (URL) can be used by a communication program (web browser) to automatically download and play online content in response to user's commands.

Conclusion:

5. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is 571-272-3977. The examiner can normally be reached on Monday through Thursday from 8:00am to 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached on 571-272-3964.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



VIET D. VU
PRIMARY EXAMINER

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5/17/05